

REMARKS/ARGUMENTS

The Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and the following remarks/arguments. By the present Amendment, claims 65 and 72 are amended. No new matter has been added. Claims 65-76 and 78-81, as herein amended, remain pending in the present application.

I. OBJECTIONS TO THE CLAIMS

The Examiner has objected to claim 65 for not including the term “being” before the term “symmetrical.” In addition, claim 72 is objected to for reciting “or” instead of “and” in line 2. In response, these claims have been amended in accordance with the Examiner’s suggestion. Accordingly, it is believed these objections have been overcome.

II. REJECTIONS UNDER 35 U.S.C. §103

The Examiner has rejected claims 65-76 and 78-81 under 35 U.S.C. §103(a) as allegedly obvious and thus unpatentable over U.S. Patent 6,932,329 to Harder in view of U.S. Patent 1,772,159 to Roth. For the reasons discussed below, the Applicants respectfully assert that independent claim 65, and the claims dependent thereon, are not obvious in view of the cited combination of references.

In determining whether a *prima facie* showing of obvious has been made, there must still be identified a suggestion or motivation to modify the references as asserted. M.P.E.P. 2143.01(I). The Federal Circuit has emphasized that the proper inquiry is “whether there is something in the prior art as a whole to suggest the *desirability*, and thus the obviousness, of making the combination.” *In re Fulton*, 391 F.3d 1195, 73 USPQ2d 1141 (Fed. Cir. 2004). It

should be noted that this requirement is distinct from a test that there be some “teaching, suggestion or motivation” to combine the references, that the U.S. Supreme Court recently rejected as being too rigid when used alone to rebut a rejection based on obviousness. *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). Instead, this requirement addresses a motivation for modifying references as asserted in order to arrive at the specific claimed invention. Specifically, the Supreme Court stated that it is required “to determine whether there was an apparent reason to combine the known elements in the fashion claimed” by the claim at issue. *KSR*, 127 S. Ct. at 1741. Thus, the Supreme Court expressly stated that there remains the requirement “to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *Id.* “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir 2006) (cited with approval in *KSR*).

In the present Office Action, the Examiner states that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the first hemispheroidal portion symmetrical to the second hemispheroidal portion *to allow the plug fastener to be inserted into the baluster 21 of Harder from either end of the plug fastener.*” Office Action of Nov. 23, 2007; pg. 4 (emphasis added). However, this statement is merely a statement of the result of the fastener being symmetrical; i.e., modifying Harder in this way would result in the plug fastener being inserted in the baluster in either orientation. But nothing is provided that identifies the reason why one skilled in the art would modify Harder's fastener in this specific manner. Of course a baluster may be placed over either end of a symmetrical plug fastener, but

what is the suggestion or motivation that would give one skilled in the art *the reason to modify Harder's fastener do this?* A reason of "because it would be beneficial to Harder to make his plug fastener reversible" is circular at best. If such a circular and conclusory statement were sufficient, then any element found in a secondary reference that would be considered a potential improvement to a primary reference's teaching would be enough to justify an obviousness rejection based on that combination. However, the patent community must be careful not to misinterpret the findings in *KSR* by thinking that the Supreme Court held that just because it might be beneficial to combine elements from different references, that combination is automatically obvious to make. Instead, the Supreme Court stated that that alone is not enough. There must be some objective reason one would seek out and decide to combine those elements in order to arrive at that benefit.

The Office Action continues "[w]ith respect to the aperture having a second countersink, it should be noted that placing a second countersink would have been obvious *since the plug fastener would have been made symmetrical so that the head of the screw can be flushed with either mating surface 33, 34.*" *Id.* Again, this is an accurate statement of the *result* of the modification of Harder's fastener if someone with hindsight is trying to arrive at the present claims. Of course a second countersink would allow a screw to be set flush on either end of a symmetrical plug fastener, but what is the suggestion or motivation that would give one skilled in the art *the reason to do this?* Again nothing is provided that identifies the *reason why* one skilled in the art would modify Harder's fastener in this manner. There must be some reason one would seek out and decide to combine the elements from the secondary reference with the primary reference in order to modify the primary reference and arrive at the claimed invention.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); M.P.E.P. 2143.01(III). Even if modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art” at the time the claimed invention was made” because the references relied upon teach that all aspects of the claimed invention were *individually* known in the art (a conclusory statement all too often cut-and-pasted by examiners), this alone is not sufficient to establish a *prima facie* case of obviousness without some objective, apparent reason to combine the teachings of the references. *Ex parte Levingood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)(emphasis in the original); M.P.E.P. 2143.01(IV). Therefore, the mere fact that the fastener in Harder could be modified to have a symmetrical structure similar to the Roth fastener is not alone sufficient to support an obviousness rejection. As we are reminded by the U.S. Supreme Court, there must be some apparent reason in the prior art to suggest to a skilled artisan the desirability of modifying the structure of the Harder fastener to include a symmetrical structure, as recited in claim 65.

Likewise, Roth makes no mention that his fastener may be mounted in either direction on a rail, or of any advantage that could be gained by having such a symmetrical fastener. The reason Roth provides a spherical fastener is so the baluster can pivot about the round, smooth surface of the fastener, in order to change the baluster’s angle with respect to the rail before it is finally secured in place. Roth ‘159 patent; page 2, Ins. 1-6. But Roth provides no teaching or suggestion regarding the advantages of being able to mount a symmetrical fastener to a rail in either direction, much less to provide ridges symmetrically opposed across the equator of the

fastener (which would actually frustrate the pivoting desired in Roth's smooth fastener). Thus, since Roth is also silent on this point, one cannot point to the teachings of either Harder or Roth "to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed in the present application. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); M.P.E.P. 2143.

Based on all of the reasoning above, we must look objectively at one skilled in the technical field of rail fasteners, having all of the knowledge generally available to one skilled in that field of art, and having the teachings of Harder and Roth in front of him, and determine if there is anything that would instill in him the desire to combining these references and modify Harder's fastener to arrive at the fastener of the present claims. Presumably, the one skilled in the art would have the goal of constructing an advantageous fastener for affixing tubular balusters onto a rail to form a railing. Looking at the Harder patent, Harder teaches the numerous advantages of a unidirectional fastener that can be first mounted to a rail, and then balusters placed over the fasteners to form the railing. The Roth patent would teach one skilled in the art that to form the railing, one should first mount the baluster to the fastener at the desired angle, and then mount this assembly to a rail. So what is there that one skilled in the art would see that would instill the desirability to arrive at the reversible fastener with symmetrical, bi-directional ridges recited in the present claims?

With regard to Harder, there is nothing in this reference that would suggest the desirability of having a symmetrical, spherical fastener with openings and countersinks on both

ends, much less to abandon the unidirectional ridges in Harder for opposing, symmetrical ridges that are taught in neither reference. These are distinct advantages of the fastener of the claims in the present application. Moreover, these are significant structural advantages over unidirectional fasteners that, if so obvious, would likely have been embodied or even envisioned in Harder. Instead, however, there is simply no suggestion in Harder to modify the unilateral fastener in Harder for a symmetrical fastener. If fact, the Harder patent includes only discussion of the advantages of the unilateral structure of the fastener disclosed therein, but there is no hint or suggestion to motivate one skilled in the art to modify the fastener in Harder to be more like the fastener in Roth.

Perhaps the motivation to modify Harder's fastener comes from the mere spherical shape of the Roth fastener? However, if its mere shape alone, with no mention of the advantage of a symmetrical structure for reversible mounting, is enough to motivate one skilled in the art to completely modify the structure of Harder, then a skilled artisan would have been just as motivated to modify the Harder fastener by any spherical shape he would see, such as a desktop globe or a bowling ball. Surely this is not the case since merely seeing the shape of objects such as these provides no suggestion of the desirability to modify the Harder fastener to be symmetrical for reversible mounting of the fastener. As with such other objects, simply seeing the shape of Roth's fastener alone provides no mention or suggestion of the desirability to modify the Harder fastener to be symmetrical as recited in the present claims. In addition, bi-directional ridges would detrimentally affect Roth's pivoting a baluster on a fastener before securing the baluster in place. Moreover, having countersinks on both ends of the fastener would

be contradictory to Roth teaching of placing the screw through the rail first, and then into the fastener.

So looking collectively at the teachings of Harder and Roth, what is provided to one skilled in the art? Harder has a unidirectional fastener with external ridges on one side of its body to grip the inside of a hollow baluster, a flat surface to mount the fastener against a rail, and a smooth aperture countersink to receive a screw therethrough that screws into the rail. Roth has a spherical fastener with a smooth external surface to allow pivoting of a hollow baluster around it, where the baluster grips the fastener by crimping the end of the baluster, and having a threaded aperture to receive a screw placed through the rail first. Even looking at all the teachings of these references, there still remains no teaching of external ridges on both sides of the fastener, along with countersinks on both sides of the fastener, to allow bidirectional mounting of the fastener. Thus, it is argued that these key structural distinctions are merely obvious by the spherical shape of Roth's fastener alone, even in the absence of any teaching or reason provided why one skilled in the art would come up with these non-taught features.

However, since the symmetrical structure of the Applicants' fastener has a significant advantage over the Harder fastener in that it may be mounted in either direction, the fact that Harder did not construct his fastener with such a symmetrical structure is also evidence that the desirability of a symmetrical structure is absent from the prior art. Similarly, the fact that Roth is silent as to any such use or potential advantage of a symmetrical structure being reversible *so that it may first be mounted onto a rail in either direction* is also evidence that the desirability of the symmetrical structure providing reversible mounting recited in the present claims is absent from the prior art. Thus, to include symmetrical ridges and countersinks on both ends of the

fastener so that it can be first mounted to a rail is contradictory to the intended function of Roth's fastener. In view of all of these reasons, one skilled in the pertinent field of art having the teachings of Harder and Roth in front of him would find nothing in the prior art that would suggest a desirability to modify the Harder fastener to include a symmetrical structure, with symmetrically opposed ridges and symmetrically opposed countersinks, so that the fastener could be mounted in either direction. That advantageous structure is an inventive feature of the present claims, and only hindsight reveals that advantage.

In sum, the above discussion makes it clear that, as expressly reiterated in *KSR*, the fastener of Harder cannot be modified in any manner unless there is a suggestion or motivation to do so, and that suggestion or motivation must be clearly articulated. Obviousness cannot be established by combining or modifying the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so. *In re Bond*, 910 F.2d 81, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). This principle did not change with *KSR*, and in fact was reiterated expressly by the U.S. Supreme Court. The rationale to support a conclusion that the claim would have been obvious is that "a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely that product [was] not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under § 103." *KSR*, 127 S.Ct. at 1741 (emphasis added). If any such finding cannot be made, as is the case here, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art. *Id.*; M.P.E.P. 2143. Even if a proposed combination would be beneficial, there must be some objective reason for someone to

seek out that benefit. Since no such teaching or suggestion or desirability to modify Harder has been or can be identified, it would not have been obvious to one of ordinary skill in the art to try to modify the fastener of Harder so as to provide a fastener with a symmetrical structure, and symmetrical ridges and countersinks, that can be mounted in either direction, as recited in the present claims.

Therefore, the combination of Harder and Roth does not render obvious independent claim 65, nor the claims dependent thereon. Accordingly, the Applicants assert that the present claims are patentable over the prior art, and thus respectfully request the Examiner withdraw the §103 rejections with respect to the pending claims.

III. CONCLUSION

The Applicants respectfully assert that claims 65-76 and 78-81, as herein amended, all recite allowable subject matter, pending the overcoming of any standing objections. The Examiner is requested to contact the Attorney of Record in needed to expedite prosecution of the present application, or to discuss any of the above arguments in further detail.

In addition, the Applicants note that the three-month deadline for filing a response to the present Office Action is February 23, 2008; thus, this Amendment is timely and no fee is required. If it is determined that any fees are due, please charge Deposit Account No. 13-0480, referencing the Attorney Docket Number specified herein.

Respectfully submitted,

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Date: February 21, 2008

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